

REMARKS

Claims 1, 4, 6-7, 11-12, 14-54, and 56-60 constitute the pending claims in this application. Claims 15-52 are withdrawn from consideration as being drawn to a non-elected invention. Applicants will cancel these claims upon indication of allowable subject matter in the elected invention. Claim 55 has been canceled without prejudice. Claims 12 and 60 have been amended. No new matter is being introduced. Applicants submit that the amendments are fully supported by the specification and the original claims. The amendments are made solely to expedite prosecution of the application, and Applicants reserve the right to prosecute claims of similar or differing scope in subsequent applications. Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the prior Office Action.

Applicants note with appreciation that the amendments put forth in Paper 23 have been entered in full.

Applicants note with appreciation that claims 1, 4, 6-7, 11, 14, 53-54, and 56-59 have been allowed.

Claim rejections under 35 U.S.C. 112, first paragraph

Claims 12 and 60 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants traverse this rejection to the extent that it is maintained over the amended claims.

Particularly, the Office Action asserts that these claims are “directed to a method of using a polypeptide encoded by a nucleic acid, which hybridizes to SEQ ID NO: 8...However, according to the instant specification, SEQ ID NO: 8 represents an open reading frame in the cDNA encoding human biglycan (see page 22, lines 29-31). Therefore, the nucleic acid which hybridizes to SEQ ID NO: 8 would be a complimentary nucleic acid.”

Solely to secure rapid allowance of claims directed to commercially relevant subject matter, Applicants have amended claims 12 and 60 to clarify that the polypeptide in the invention “is encoded by a nucleic acid which hybridizes under stringent conditions of 6.0 x sodium chloride/sodium citrate (SSC) at about 45 °C to a complementary strand of SEQ ID NO: 8.” These amendments are fully supported by the original specification (e.g., page 23, lines 31-34). As amended, claims 12 and 60 satisfy the enablement requirement as one of skill in the art would know how to use and make the claimed methods without undue experimentation at the time when the invention was filed. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. 112, first paragraph, is respectfully requested.

Double Patenting

Claim 55 is objected to under 37 C.F.R. 1.75, as being a substantial duplicate of claim 53. Solely to expedite prosecution, Applicants have canceled claim 55 without prejudice. This amendment is not made in acquiescence of the rejection, and Applicants reserve the right to prosecute claims of similar or differing scope. Reconsideration and withdrawal of this objection is respectfully requested.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims are now in condition for allowance and early notification to this effect is earnestly solicited. Any questions arising from this submission may be directed to the undersigned at (617) 951-7000.

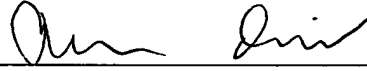
If there are any other fees due in connection with the filing of this submission, please charge the fees to our **Deposit Account No. 18-1945**. If a fee is required for an

extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit account.

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Respectfully Submitted,



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